<u>Remarks</u>

Claims 1-24 are pending, but stand rejected. In view of the following remarks, the Applicant respectfully requests the Examiner's thoughtful reconsideration. The Applicant also asks that the Examiner take the time to address all of the limitations of Claim 10. With respect to Claim 10, the Examiner fails to address the limitation of receiving input that specifies at least one print job criterion and an e-mail address.

CLAIM REJECTIONS – 35 USC §102

Claims 1-8, 10-11, 13-17, and 19-24 were rejected under 35 U.S.C. §102 as being unpatentable over USPN 6,975,419 issued to Staas.

Claim 1 is directed to a method of transmitting a message and recites the following elements:

a) determining if a device encounters an event while processing a job;

b) determining if the job meets a pre-determined criterion; and

c) transmitting a message to a remote destination when each of a set of pre-determined conditions exist, the pre-determined conditions include:

    a. determination that the device encountered the event while processing the job; and

    b. a determination that the job met the pre-determined criterion.

Rejecting Claim 1, the Examiner relies on Staas, Abstract, Figs. 1, 3B, and 6A. Staas discusses a system designed for e-mail printing. In particular Staas discusses system in which a printer is associated with an e-mail address. Email messages received at that address are converted into print jobs to be printed by that printer. *See, e.g.*, Staas, Abstract, Fig. 1, and col. 2, lines 9-38.

Staas, Figs. 3A and 3B illustrate flow diagrams charting a process for printing an email. In step 326, print jobs are created for a received email and attachment thereto. For each of those print jobs, a rendering application is

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identified in step 329. A rendering application is an application that renders the print job into a printer ready format. Staas, col. 6, lines 4-17. Once rendered into a printer ready format, it is determined if there are any errors in step 339. Staas explains that an error results if the rendering application is not capable of fulfilling a particular print option of a print job or simply not able to perform the rendering function at all. Staas, col. 11, lines 50-64. Upon detection of an error, a message is returned to the sender of the email in step 343.

In rejecting Claim 1, the Examiner equates step 329 with both the act of determining if a device encounters an event while processing a job and the act of determining if the job meets a pre-determined criterion as recited in Claim 1. Staas' step 339 is simply a determination of whether a rendering application encountered a problem in rendering a print job. With respect to Claim 1, step 339 is at best a determination as to whether a device has encountered an event – that event being an error with respect to the rendering application. Staas's step 339 has nothing to do with determining if the job (the email attachment thereto, or resulting print job) meets a predetermined criterion.

Therefore, the message returned in Staas' step 343 is not transmitted when each of a set of predetermined conditions exist where those conditions include (a) a determination that the device encountered the event while processing the job **and** (b) a determination that the job met the pre-determined criterion.

Staas Figs. 6A and 6B illustrate flow diagrams charting a process for retrieving and printing a document referenced in an e-mail print request. Staas, col. 15, lines 19-37. After receiving an email request in step 430, it is determined if the email is of proper format in step 446. if not, a message is returned to the sender of the email request in step 449. If the email request is properly formatted, it is determined is a file referenced in the email request can be found in step 456. If not, a message is returned to the sender of the email request. If the file can be found, it is determined if the file is to be forwarded on to a recipient other than the sender of the email request. If so, an email containing the file is forwarded in steps 466, 473, and 476. If not, an email containing the file is returned to the sender of the email request in steps 469, 473, and 476.

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In rejecting Claim 1, the Examiner equates each of steps 446, 456, and 463 with both the act of determining if a device encounters an event while processing a job and the act of determining if the job meets a pre-determined criterion as recited in Claim 1. Each of Staas' steps 446 and 463 is simply a determination as to a format of a request email – either a proper format in step 446 or a document forward format in step 463.

With respect to Claim 1, steps 446 and 463 are at best determinations as to whether an email request meets a predetermined criterion (proper format or document forward indication). Staas's steps 446 and 463 have nothing to do with determining if a device has encountered an event while processing the email request. Therefore, neither the message returned in Staas' step 449 nor the email forwarded in steps 466, 473, and 476 are transmitted when each of a set of predetermined conditions exist where those conditions include (a) a determination that the device encountered the event while processing the job **and** (b) a determination that the job met the pre-determined criterion.

Furthermore Staas step 456 is simply a determination of whether a file referenced in an email request can be found. With respect to Claim 1, step 456 is at best a determination as to whether a device has encountered an event – that event being not being able to find a file. Staas's step 339 has nothing to do with determining if the file or email request meets a predetermined criterion. Therefore, the message returned in Staas' step 459 is not transmitted when each of a set of predetermined conditions exist where those conditions include (a) a determination that the device encountered the event while processing the job **and** (b) a determination that the job met the pre-determined criterion.

As such, not one of Staas' messages returned in steps 343, 449, 459, or 466 is transmitted to a remote destination when each of a set of pre-determined conditions exist where those pre-determined conditions include (a) a determination that the device encountered the event while processing the job **and** (b) a determination that the job met the pre-determined criterion. Instead only one condition needs to be met before transmitting any one of Staas' messages.

Consequently, Staas fails to teach or suggest a method that includes transmitting a message to a remote destination when each of a set of pre-

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determined conditions exist, where the pre-determined conditions include: a determination that the device encountered the event while processing the job; and a determination that the job met the pre-determined criterion.

For at least these reasons, Claim 1 is patentable over Staas as are Claims 2-9 due at least in part to their dependence from Claim 1.

Claim 10 is directed to a method of transmitting a message and recites the following elements:

a) receiving input that specifies at least one print job criterion and an e-mail address;

b) submitting a print job to a printer for processing;

c) determining if a device encounters an event while processing a job;

d) determining if the job meets the pre-determined criterion; and

e) if it is determined that the print job meets the at least one print job criterion and that the printer encountered an event while processing the print job, then transmitting an e-mail message to the e-mail address.

It is initially noted that the Examiner does not address the recitation of receiving input that specifies at least one print job criterion and an e-mail address. For this reasons alone, the rejection of Claim 10 is defective and cannot stand.

As clarified above with respect to Claim 1, Staas simply does not teach or suggest (1) determining if a device encounters an event while processing a job, (2) determining if the job meets the pre-determined criterion, and then (3) sending of an e-mail message to the e-mail address if it is determined that the print job meets the at least one print job criterion **and** that the printer encountered an event while processing the print job.

For at least these reasons, Claim 10 is patentable over Staas as are Claims 11-14 due at least in part to their dependence from Claim 10.

Claim 15 is directed to a computer readable medium embodying a program of instructions for causing a computer to perform the followings:

(a)   receiving a request from a user to print a document:

(b)   in response to the request, performing the following substeps:

    (i)   accessing the document to determine if the document has at least one characteristic;

    (ii)   submitting a print job that describes the document to a printer;

    (iii)   determining if the printer encounters an event while processing the print job; and

    (iv)   if it is determined that the print document has the at least one characteristic and that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

As clarified above with respect to Claims 1 and 10, Staas simply does not teach or suggest if it is determined that the print document has the at least one characteristic **and** that the printer has encountered the event while processing the job, then commanding a device to transmit a message to a pre-determined address.

For at least these reasons, Claim 15 is patentable over Staas as are Claims 16-18 due at least in part to their dependence from Claim 15.

Claim 19 is directed to a computing system that includes the following elements:

a)   means for receiving input from a user that specifies at least one print job criterion;

b)   means for receiving a request from the user to submit a print job to a printer;

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c) means for responding to the request by submitting the print job to the printer;

d) means for determining if the print job meets the criterion;

e) means for determining is the printer encounters an event; and

f) means for transmitting a message to an address upon a determination that the print job meets the criterion and that the printer has encountered the event.

As clarified above with respect to Claim 1, Staas simply does not teach or suggest means for transmitting a message to an address upon a determination that the print job meets the criterion **and** that the printer has encountered the event.

For at least these reasons, Claim 19 is patentable over Staas as are Claims 20-24 due at least in part to their dependence from Claim 15.

CLAIM REJECTIONS – 35 USC §103

Claims 9, 12, and 18 were rejected under 35 U.S.C. §103 as being unpatentable over Staas in view of various other references. Claim 9 depends from Claim 1 and includes all the limitations of that base claim. For at least the same reasons Claim 1 is patentable, so is Claim 9. Claim 12 depends from Claim 10 and includes all the limitations of that base claim. Claim 18 depends from Claim 15 and includes all the limitations of that base claim.   For at least the same reasons Claims 10 and 15 is patentable, so are Claim 12 and 18.

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Conclusion

In view of the foregoing remarks and amendments, Applicant respectfully submits that Claims 1-24 define allowable subject matter. The Examiner is requested to indicate the allowability of all claims in the application and to pass the application to issue.

Respectfully submitted,
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